Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

X] Responsive to communication(s) filed on _May 29, 1998_

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____3___ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

   X] Claim(s) _1-50_____ is/are pending in the applicat

     Of the above, claim(s) _____ is/are withdrawn from consideration

   ☐ Claim(s) _____ is/are allowed.

   X] Claim(s) _1-50_____ is/are rejected.

   ☐ Claim(s) _____ is/are objected to.

   ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

   X] See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

   X] The drawing(s) filed on _____ _May 29, 1998_____ is/are objected to by the Examiner.

   ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐disapproved.

   ☐ The specification is objected to by the Examiner.

   ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

   ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

     ☐ All ☐Some* ☒None of the CERTIFIED copies of the priority documents have been

       ☐ received.

       ☐ received in Application No. (Series Code/Serial Number) _____ .

       ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

     *Certified copies not received: _____

   ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

   X] Notice of References Cited, PTO-892

   X] Information Disclosure Statement(s), PTO-1449, Paper No(s). _____2-5_____

   ☐ Interview Summary, PTO-413

   X] Notice of Draftsperson's Patent Drawing Review, PTO-948

   ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

Election/Restriction

1.   Restriction to one of the following inventions is required under 35 U.S.C. 121:

    I.   Claims 1-26, and 38-50 are drawn to a message redirection system, classified in

        class 709, subclass 206.

    II.   Claims 27-37 are drawn to a data updating/synchronization system, classified in

        class 709, subclass 248, and class 707, subclass 201.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that (1) they

are not disclosed as capable of use together, (2) they have different modes of operation, (3) they

have different functions, or (4) they have different effects (MPEP § 806.04, MPEP § 808.01). In

the instant case, inventions I and II are not disclosed as capable of use together, have different

functions, have different modes of operation, and have different effects.

These inventions are distinct for the reasons given above, and the search required for each

group is different and not co-extensive for examination purposes. For example, the searches for

inventions would not be co-extensive because these groups would require different searches on

PTO's classification class and subclass as follows:

(a) the group I search (claims 1-26, and 38-50) would require use of search Class 709, subclass 206 (not required for invention II).

(b) the group II search (claims 27-37) would require use of search Class 709, subclass 248, and class 707, subclass 201 (not required for inventions I).

During a telephone conversation with Mr. David Cochran on February 4, 2000, a provisional election was made with traverse to prosecute the invention of group I, claims 1-26, and 38-50. Affirmation of this election must be made by applicant in replying to this Office action. Claims 27-37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Drawings

2.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do

not include the following reference sign(s) mentioned in the description: Server 11, mentioned on

pages 15-17, is not shown on Figure 2. Correction is required.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and
> distinctly claiming the subject matter which the applicant regards as his invention.

4.   Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing

to particularly point out and distinctly claim the subject matter which applicant regards as the

invention.

The phrase "data elements that have been redirected" in claim 41 lacks sufficient

antecedent bases. It is noted that claim 39 provides sufficient antecedent basis for the claim 41.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United
> States before the invention thereof by the applicant for patent, or on an international application by another who

has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6.   Claims 1-2, 19-21, 23-24, 38-39, 42-45, 47, and 49 are rejected under 35 U.S.C. 102(e)

as being anticipated by Beletic et al. (U.S. Patent No. 5,706,211, hereinafter "Beletic").

In considering claim 1, Beletic discloses a method of pushing data items from a host

system (20) to a mobile communication device (28) (col. 2, lines 51-64) comprising the steps of:

detecting an event trigger at the host system; and

in response to detecting the event, continuously redirecting the data items from the host

system to the mobile communication device (col. 3, lines 21-35).

In considering claim 2, Beletic further discloses selecting at least one type of data item to

redirect from the host system to the mobile device (col. 3, lines 1-2).

In considering claim 19, Beletic further discloses the mobile device being a pager (col. 1,

lines 11-14).

In considering claim 20, Beletic further discloses the mobile device equipped to receive

both voice and non-voice data messages (col. 3, lines 17-18).

In considering claim 21, Beletic further discloses the host system including a preferred list for limiting the redirection to items sent from senders on the preferred list (col. 16, lines 5-10).

In considering claim 23, Beletic further discloses the preferred list being activated at the host system (col. 16, lines 5-6).

In considering claim 24, Beletic further discloses the preferred list being activated and deactivated by a command message transmitted from the mobile device to the host system (col. 15, line 67 - col. 16, line 10).

In considering claim 38, Beletic discloses a method of remotely controlling a host system from a personal communications device comprising the steps of:

establishing at the host system a set of commands that can be invoked to require the host system to act in response to invocation of any such command;

sending from the personal communications device a direction to the host system to invoke a command from the set of commands;

invoking the command at the host system; and

processing the command so that the host responds to the command.

(col. 15, line 64 - col. 16, line 10)

In considering claim 39, Beletic further discloses one command being a direction to continuously redirect certain data elements from the host system to the personal communications system (col. 16, lines 5-10).

In considering claim 42, Beletic further discloses transmitting from the personal communications device to the host device an acknowledgment message (col. 8, lines 27-35).

In considering claim 43, Beletic further discloses the personal communications device being able to limit the information being sent to it by transmitting a command to the host device (col. 16, lines 5-10).

In considering claim 44, Beletic discloses a system for pushing information from a host system to a mobile data communication device, comprising:

a communication network over which the host system and the mobile data communications device communicate (Fig. 1);

software instruction means for prompting a user to select certain data items of information to be pushed to the mobile device (col. 16, lines 8-10);

software instruction means for defining one or more events that will trigger the system to begin pushing the selected information (col. 16, lines 5-10);

software instruction means for detecting the occurrence of the one or more events and for

pushing the selected data items of information from the host system to the mobile data

communication device via the network (col. 16, lines 5-10); and

a software program operating at the mobile data communications device for receiving the

data items of information from the host system (col. 1, lines 44-58).

In considering claim 45, Beletic further discloses the redirector program operating at the

host system (col. 3, lines 7-20).

In considering claim 47, Beletic further discloses the host system including a preferred list

for limiting the redirection to items sent from senders on the preferred list (col. 16, lines 5-10).

In considering claim 49, Beletic further discloses the preferred list being activated and

deactivated by a command message transmitted from the mobile device to the host system (col.

15, line 67 - col. 16, line 10).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 7, 40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beletic.

In considering claim 7, although the teaching of Beletic discloses substantial features of the claimed invention, it fails to disclose configuration information including the types of data item attachments that the mobile data communication device can receive and process. Nonetheless, it would be obvious to a person having ordinary skill in the art that any data processing communications system must be able to determine which devices in the system can receive and process specific types of data, so that all messages can be correctly received. Therefore, the claimed invention would be obvious over the teaching of Beletic.

In considering claim 40 and 41, although the teaching of Beletic discloses substantial features of the claimed invention, it fails to disclose the host system providing an indication that data has been redirected, wherein redirected elements are marked at the host system. Nonetheless, log files for forwarding are well known in the art. Therefore, it would have been obvious to a person having ordinary skill in the art to use a forwarding log file to keep track of forwarded messages at the host system for security and record-keeping purposes.

9.   Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beletic in

view of Foladare et al. (U.S. Patent No. 5,978,837, hereinafter "Foladare").

In considering claim 9, although the teaching of Beletic discloses substantial features of

the claimed invention, it fails to disclose:

determining whether each data item includes an attachment, and determining the type of

attachment;

determining whether the mobile data communication device can receive and process such

attachments; and

if so, then redirecting the attachments to the mobile data communication device, and if

not, then redirecting the attachments to an external machine that is compatible with the

attachment.

Nonetheless, this is well known, as evidenced by Foladare. In a similar art, Foladare

describes an e-mail forwarding system wherein messages requiring a specific format are sent to a

pager and can then be forwarded to different external machines, depending on the format of the

message (col. 3, lines 20-25). Given the teaching of Foladare, a person having ordinary skill in

the art would have readily recognized the desirability and advantages of redirecting messages to

compatible machines, as taught by Foladare, in the system taught by Beletic so that all types of

messages can be sent and received through the redirection system. Therefore, the claimed

invention would have been obvious over Beletic in view of Foladare.

In considering claim 10, Beletic further discloses a type of message beign a sound file (col. 3, lines 16-18).

10.   Claims 4-6, 8, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beletic, in view of Yeager et al. (U.S. Patent No. 5,745,689, hereinafter "Yeager").

In considering claim 4, although the system taught by Beletic discloses substantial features of the claimed invention, it fails to disclose providing information regarding the configuration of the mobile data communication device. Nonetheless, providing configuration information of a communication device to devices with which it communicates is well known, as evidenced by Yeager. In a similar art, Yeager discloses a message forwarding system wherein configuration information is provided (col. 7, lines 8-12). Given the teaching of Yeager, a person having ordinary skill in the art would have readily recognized the desirability and advantages of providing configuration information, as taught by Yeager, in the remote messaging system taught by Beletic so that the host system knows where and how to forward messages to the remote device. Therefore, the claimed invention would have been obvious over Beletic in view of Yeager.

In considering claim 5, Yeager further discloses configuration information including the address of the mobile device (col. 7, lines 23-25). It would be obvious to include the address of the mobile device so that the message can be sent to the mobile device.

In considering claim 6, Yeager further discloses configuration information including the type of mobile device (col. 7, lines 8-12). It would be obvious to include the type of mobile device so that the device can recognize the message.

In considering claim 8, Beletic further discloses repackaging the data items prior to redirection by placing the data items in an electronic wrapper (col. 5, lines 39-41, "encoding"). Yeager further discloses the message being addressed using the address information of the mobile device (col. 7, lines 23-25).

In considering claim 17, Beletic further discloses receiving the repackaged data items at the mobile device, removing the electronic wrapper from the data items ("decoding"), and storing the messages (col. 6, lines 49-52).

11.   Claims 3, 11-16, 18, 22, 25, 26, 48, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beletic, in view of Kikinis (U.S. Patent No. 5,838,252).

In considering claim 3, although system taught by Beletic discloses substantial features of the claimed invention, it fails to disclose selecting particular event triggers that will cause the host system to begin redirecting the data items. Nonetheless, the selection of event triggers in a mobile communication system is well known, as evidenced by Kikinis. In a similar art, Kikinis discloses a paging system wherein the user can set specific event triggers which notify a system to send

desired information to a mobile device (col. 4, lines 22-30). Given the teaching of Kikinis, a

person having ordinary skill in the art would have readily recognized the desirability and

advantages of setting specific event triggers, as taught by Kikinis so that the user of the mobile

device can choose to receive or not to receive messages, depending on the user's desires.

Therefore, the claimed invention would have been obvious over Beletic in view of Kikinis.

In considering claim 11, Kikinis further discloses the event trigger including external

events, internal events, or networked events (col. 4, lines 22-30). It would be obvious to include

these events so that the trigger can be chosen from a user anywhere on the system.

In considering claim 12, Kikinis further discloses the external event being a message from

the mobile device (col. 57-61). It would be obvious for an event message to be from the mobile

device so that the trigger can be chosen from a remote location should the user be away from the

host system.

In considering claim 13, although the combined teaching of Beletic and Kikinis does not

disclose the use of a calendar alarm to trigger an event, the use of calendar events to trigger

events is well known in the art. A person having ordinary skill in the art would have readily

recognized the desirability and advantage of using a calendar alarm to trigger an event so that the

user can set specific times to redirect messages. Therefore, a calendar alarm, as claimed in claim 13, would be an obvious design choice for triggering an event.

In considering claim 14, although the combined teaching of Beletic and Kikinis does not disclose the use of a screen saver activation to trigger an event, the use of screen saver activation to trigger events is well known in the art. A person having ordinary skill in the art would have readily recognized the desirability and advantage of using a screen saver activation to trigger an event so that messages are redirected when the user may not be present. Therefore, a screen saver activation, as claimed in claim 14, would be an obvious design choice for triggering an event.

In considering claim 15, although the combined teaching of Beletic and Kikinis does not disclose the use of a keyboard timeout signal to trigger an event, the use of a keyboard timeout signal to trigger events is well known in the art. A person having ordinary skill in the art would have readily recognized the desirability and advantage of using a keyboard timeout signal to trigger an event so that messages are redirected when the user may not be present. Therefore, a keyboard timeout signal, as claimed in claim 14, would be an obvious design choice for triggering an event.

In considering claim 16, Kikinis further discloses the network event being a message from a computer system connected to a host system on a network (col. 4, lines 22-26). It would be obvious for a message to be from a network computer system so that the trigger can be chosen from a user anywhere on the network, should the user be away from the host system and the mobile device.

In considering claim 18, Beletic further discloses the steps of:

providing the address of the host system to the mobile data communication device;

generating a reply data item at the mobile data communication device in response to a data item received from the host system; and

repackaging the reply data item by placing it in an electronic wrapper addressed using the address information of the host system.

(col. 8, lines 27-34, "acknowledgement")

In considering claim 22, although the teaching of Beletic discloses substantial features of the claimed invention, it fails to disclose that the user can add or subtract senders from the preferred list. Nonetheless, the selection of specific messages to be forwarded is well known, as evidenced by Kikinis. Kikinis discloses a system for forwarding stock quote information to a pager wherein the user of the pager can select and change the stock quotes being forwarded to the pager (col. 5, lines 21-30). Given the teaching of Kikinis, a person having ordinary skill in the art

would have readily recognized the desirability and advantages of selecting preferred message

reception so that the user can filter out undesired messages. Therefore, the claimed invention

would have been obvious over Beletic, in view of Kikinis.

In considering claim 25, Beletic further discloses a preference list existing on a host system

(col. 16, lines 5-10).

In considering claim 26, Kikinis further discloses altering a list of preferred senders by

transmitting a command message from the mobile device to the host system (col. 4, lines 53-61).

It would be obvious to alter the list with a command from the mobile device so that the list can be

changed if the user is away from the host system.

In considering claim 48, although the teaching of Beletic discloses substantial features of

the claimed invention, it fails to disclose means for adding or subtracting senders from the

preferred list. Nonetheless, the selection of specific messages to be forwarded is well known, as

evidenced by Kikinis. Kikinis discloses a system for forwarding stock quote information to a

pager wherein the user of the pager can select and change the stock quotes being forwarded to the

pager (col. 5, lines 21-30). Given the teaching of Kikinis, a person having ordinary skill in the art

would have readily recognized the desirability and advantages of selecting preferred message

reception so that the user can filter out undesired messages. Therefore, the claimed invention

would have been obvious over Beletic, in view of Kikinis.

In considering claim 50, Kikinis further discloses the means for adding or subtracting

comprising transmitting a command message to the host system from the mobile device (col. 4,

lines 53-61). It would be obvious to add or subtract users with a command from the mobile

device to allow the user to change preferences should the user be away from the host.

12.   Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beletic, in view of

Kikinis, and further in view of Yeager.

Although the combined teaching of Beletic and Kikinis discloses substantial features of the

claimed invention, it fails to disclose the redirector program operating at a network server.

Nonetheless, redirector programs operating at network servers are well known, as evidenced by

Yeager. In a similar art, Yeager discloses a pager system wherein data is forwarded from a sender

to the pager at a pager server (col. 5, lines 7-13). Given the teaching of Yeager, a person having

ordinary skill in the art would have readily recognized the desirability and advantages of using a

server for message forwarding, as described by Yeager, in the system described by Beletic and

Kikinis to free up processing space on the host system. Therefore, the claimed invention would

have been obvious over the Beletic and Kikinis in view of Yeager.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess, can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7201.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3900.

GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2700

BE

February 8, 2000